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OFFICE OF PETITIONS

DECISION ON RENEWED PETITION

In re Application of
Kurt R. Lehman et al.
Application No. 10/623,953
Filed: July 21, 2003
Attorney Docket No. KLA1P015AD2/P611A2
Title: In-Situ Metalization Monitoring using
Eddy Current Measurements During the
Process for Removing the Film

This is a decision on the renewed petition filed January 29, 2004, pursuant to 37 C.F.R. §1.137(f), to revive the above-identified application.

A grantable petition pursuant to 37 CFR 1.137(f) must be accompanied by:

- (1) Notification of the filing of an application in a foreign country or under a multinational treaty that requires 18 month publication¹;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(m), and;
- (3) A statement that the entire delay in filing the notice from the date that the notice was due under 35 U.S.C. §122(b)(2)(B)(iii) until the date the notice was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

On September 22, 2003, the original petition was filed with the Office, which was dismissed via the mailing of a decision on January 9, 2004, for failure to include notification of the filing of the foreign or international application.

With the renewed petition, Petitioner sets forth that the instant nonprovisional application is the subject of an application filed in either a foreign or an international application on December 22, 2000.

¹ See PTO/SB/36 and paragraph on PTO/SB/64a for further information. Both may be downloaded at <http://www.uspto.gov/web/forms/index.html>.

The record discloses that on July 21, 2003, the date of filing of the instant application, a Request and Certification under 35 USC 122(b)(2)(B)(i) was filed, certifying that "the invention disclosed in the attached **application has not and will not** be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing." This request was signed by the petitioner, over the equivalent of his registration number².

On September 22, 2003, the original petition was filed, which constituted the equivalent of a Request to Rescind the Nonpublication Request. This request did not reveal the filing date of the international application. With the renewed petition, Petitioner now requests under 35 USC 122(b)(2)(B)(ii) that the Request and Certification under 35 USC 122(b)(2)(B)(i) be rescinded and the application revived because this application became abandoned for failure to notify the Office within 45 days of the filing of a corresponding international or foreign application. In this regard, petitioner states that an international or foreign application corresponding to the instant application was filed on **December 22, 2000**, which is **prior** to the date of filing the instant application.

The instant nonprovisional application did not become abandoned as a result of the published international application filed prior to the present application. In this regard, 35 USC 122(b)(2)(B)(iii) states:

An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional (emphasis added).

The facts of this case are that the subject application was filed on December 22, 2000, and the corresponding application was filed July 21, 2003. The statute does not provide for the situation where a certification under 35 USC 122(b)(2)(B)(i) was made, despite the fact that an application was previously filed in another country or under a multilateral agreement. The statute at 35 USC 122(b)(2)(B)(iii) only provides for revival in the situation where a certification was made under 35 USC 122(b)(2)(B)(i) at the time of filing the application and an application was subsequently filed in a foreign country without notifying the Office within 45 days of the filing thereof.

In view of the above, and since this application did not become abandoned pursuant to the provisions of 35 USC 122(b)(2)(B)(iii), a petition to revive under the provisions of 37 CFR 1.137(f) is inappropriate and must be dismissed.

Therefore, the petition is **DISMISSED AS INAPPROPRIATE**.

The previous Request and Certification under 35 U.S.C. §122(b)(2)(B)(i), filed with the original application papers, has been rescinded. Unfortunately, due to a software problem the Office is currently experiencing, the Office cannot determine the projected publication date at this time.

² The Petitioner has a limited recognition to practice before the Office, pursuant to 37 C.F.R. §10.9(b).

The rules and statutory provisions governing the operations of the US Patent and Trademark Office require payment of a fee on filing each petition³. Payment of the \$1,300 petition fee is acknowledged.

After the mailing of this decision, the application file will be forwarded to Technology Center 2800 for further processing.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
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Office of Petitions
United States Patent and Trademark Office

³ 35 USC §41(a)(7).